

PATENT
Docket NCR-11453

REMARKS

Reconsideration of the above identified application is respectfully requested.

Applicants note the substantial breadth of interpretation of Applicants' claims being proffered by the examiner, which correspondingly enlarges claim scope in later infringement analysis of the file wrapper. However, the examiner has failed to afford due weight to specific features and cooperation of features which distinguish over the applied art.

Applicants traverse the rejection of claims 1-16, 18-21, 23-28, and 30 under Section 102(b) over Mertens et al.

An anticipation rejection is highly technical and requires identity of elements arranged in the recited combination.

The fundamental problem or error with the examiner's various contentions is the failure by the examiner to identify or define in Mertens any analogous "adhesive patch" in the first instance.

That failure then leads the examiner to gross distortions of the express features of Mertens which the examiner merely contends read on the claims being rejected.

Claim 1 recites a plurality of adhesive patches 38 aligned in a column along the running axis 32 of the web in a minor area of the back surface, with the major area being devoid of adhesive.

The examiner expressly applies figures 5 and 7 of Mertens (for two similar embodiments) to anticipate these features, but those figures clearly do not show analogous adhesive patterns.

Figures 5 & 7 of Mertens clearly illustrate two solid bands of adhesive 94, 94a spaced transversely apart and extending continuously along the longitudinal running axis of the web 80. And, figure 6 illustrates the resulting two split rolls 124a,b, each now having a single solid band of adhesive 94a and 94b running continuously along the running axis.

Where then is the examiner's support for the mere

PATENT
Docket NCR-11453

contention that figures 5 & 7 illustrate "a plurality of adhesive patches aligned in a column ...?"

Those figures do indeed illustrate two columns of adhesive 94,94a,b, but each column is continuous and solid in a single adhesive element, and do not illustrate a plurality of adhesive patches as expressly recited in claim 1.

Independent claim 19 has a similar recitation of columnar adhesive like that recited in claim 1, and is equally distinguishable over Mertens.

Furthermore, claim 1 also recites that the web back surface 36 is devoid of adhesive other than at the column of adhesive.

This is in stark contrast with Figures 5 & 7 of Mertens being used by the examiner which show the second band of adhesive in addition to the first band of adhesive. Where then is the devoid portion of the web as recited in claim 1?

However, the examiner's attention is directed to figure 6 of Mertens where the double-band wide roll 116 is split into two narrow rolls 124a,b, each of which has a single, continuous band of adhesive 94a,b, which, yet again is clearly not a plurality of adhesive patches, but a singular, continuously long band.

Independent claim 19 and claim 2 recite that the column of patches 38 is aligned closer to one edge than to the opposite edge.

However, figures 5 & 7 applied by the examiner have two bands 94,94a,b which cannot be closer to one edge than the other edge because the band 94a, for example, is closer to one edge, but the other band 94b in the group is closer to the opposite edge.

Since figures 5 & 7 of Mertens show only two bands, and a plurality of two bands is required to meet the definition of a "plurality," the examiner has failed to show that those two bands 94a,b are aligned with each other in a column, when that is impossible due to their parallel spacing.

PATENT
Docket NCR-11453

As for claim 4 the straight edges of the bands 94,a,b in Mertens are continuous along the running axis, and do not a plurality of patches define.

As for claim 5, the examiner's statement of "transverse" edges is not supported by any evidence in Mertens, and is quite impossible. The two bands 94,a,b run only longitudinally and do not define a plurality of patches having edges extending transversely across the width of the web, and the examiner has not shown otherwise.

Claims 6, 7, 23, & 24 recite a plurality of rectangular patches aligned in a column along the running axis, and Mertens clearly illustrates only two bands which are continuous along the running axis, and do not define more than one rectangular patch aligned in a column as recited in these claims.

Claims 8, 15, 21, & 25 recite index marks 42 between the adjacent patches 42, with each label having a single patch.

This is in stark contrast with Mertens, and the examiner's reference to col. 10, ll. 45-65, uses the eyemarks 146 which are clearly not between adjacent patches in a column, since each band 94a,b is continuous and the two bands are used to define two labels, not a single label in the web.

Claims 9 & 10 recite a plurality of transverse elongate patches 38C, and the examiner's use of Col. 8, ll. 5-21 does not anticipate this configuration.

The examiner has already argued that Mertens discloses elongate patches along the running axis as recited in claim 7; and the examiner's attempt to use Mertens for the mutually exclusive transverse embodiment lacks consistency, or logic, or evidence.

Figures 5 & 7 being used by the examiner clearly illustrate longitudinally continuous, and therefore, elongate bands 94,a,b which are clearly not both in a column along the running axis and also elongate transverse across the width of the web, and the examiner has not shown or explained otherwise.

It is quite impossible for the bands 94,a,b to be elongate in

PATENT
Docket NCR-11453

two orthogonal directions, and the examiner has not explained this.

The other species disclosed by Mertens at col. 8 are not illustrated, and would appear to be similar to the illustrated bands as also being longitudinally continuous, and the examiner has not shown otherwise.

Claims 10 & 30 recite that this transverse species is devoid of index marks between the patches, and the examiner's reference to "Figure 10" of Mertens fails to conform with the written specification which, to the contrary, requires that the species in figure 10 have the same eyemarks 146 shown in identical figure 5 embodiment, except for a non-relevant feature.

The examiner's contentions regarding claims 11-14 and 20 defy credulity, and the mere recapitulation of the features from these claims in the examiner's remarks is not supported by Mertens, and the examiner has not shown otherwise.

The examiner applies figure 7 of Mertens for plural labels, with four GFS labels being illustrated. But, claim 11 recites that each label has a plurality of adhesive patches, and figure 7 plainly illustrates a single, continuous adhesive portion of the bands 94a,b in each of the GFS labels. Where then is the evidentiary support for plural patches?

Claim 12 recites that the patches 38 have arcuate edges transversely, which the examiner simply recapitulates in the remarks without identifying any analogous structure in Mertens.

Figures 5 & 7 used by the examiner plainly show long bands 94,a,b with no transverse edge whatsoever, let alone arcuate.

The col. 8 species found in Mertens are not illustrated, but appear to be longitudinally continuous species of the two straight bands 94,a,b lacking any nexus with claim 12, and the examiner has not shown otherwise. Perhaps the examiner would prepare figures of what the species of col. 8 would entail.

A Section 102 rejection mandates clear evidence, which would also be mandated under Section 103, and the examiner's

PATENT
Docket NCR-11453

mere rote assertion of analogous features is not evidence, and is without merit.

Claim 13 recites the convex leading and trailing edge species of the patches, nowhere shown or disclosed in Mertens, and the examiner has not shown otherwise.

The two bands 94,a,b in Mertens are plainly longitudinally continuous, and are clearly not segmented longitudinally in plural patches having convex features.

Claims 14 & 20 recite the oval species, and the examiner's rote reference to Mertens fails to support this rejection.

The two bands 94,a,b are clearly longitudinally continuous and lack any similarity whatsoever to plural, oval patches. And, the examiner has failed to show how any of the other species merely mentioned in Mertens are in fact oval as recited in these claims, when at best they are species of the longitudinally continuous bands 94,a,b.

The examiner's comments regarding claims 16 & 26 for full release strip lacks support for the combination with the plural patches also recited in these claims.

And, the silicone coating recited in claim 28 is not anticipated by the col 2 reference proffered by the examiner, because that reference is found in the background section, and not in the detailed description.

In the various contentions presented by the examiner under para. 2 of the office action, the examiner leaves to speculation what elements and features of Mertens should be used in anticipating the various claims; and how those elements should be interpreted. At best, the examiner merely broadens the scope of the various claims by the failure to be specific in applying Mertens.

Rejections under Section 102 require identity between elements in the identical combination, and the examiner has failed to show this identity in the various claims being rejected based on the different species disclosed in Mertens.

The examiner is duty bound to select one species at a time

PATENT
Docket NCR-11453

in Mertens in the attempt to support the rejection of each claim, and is not permitted to select different features from different species in fabricating a combination rejection under Section 102.

Mertens is quite clear in the many figures thereof, and consistently shows and describes longitudinally continuous adhesive bands 94, 94a, 94b extending apparently along the full running axis of the various webs disclosed therein, and it is not seen how the examiner can possibly interpret each of those continuous bands as somehow not being continuous, but, instead, comprising a plurality of discrete adhesive patches as recited in the claims.

The rejection of these various claims therefore lacks merit ab initio, and should the examiner persist, the examiner is requested to explain in detail for the record what interpretation of Mertens is being proffered for each and every claim. Otherwise, those claims will have unlimited breadth of scope when distinguished over Mertens.

Accordingly, withdrawal of the rejection of claims 1-16, 18-21, 23-28, and 30 under Section 102(b) over Mertens et al is warranted and is requested.

Applicants traverse the rejection of claims 1-8, 15, 17-19, 22-25, 28, and 29 under Section 102(b) over Miles et al.

Like the previous rejection, the examiner has failed to specifically identify any plurality of adhesive patches aligned in a column in Miles, and the mere recapitulation of Applicants' own claim language in the examiner's remarks is not substantiated by any evidence in Miles.

Figures 5 & 10 of Miles clearly illustrate a continuous band or stripe of the RPSA adhesive 26,226 extending along the running axis of rolls, which renders quite impossible any interpretation by the examiner of a plurality of aligned patches. Where then in Miles does the examiner find any illustration or disclosure of analogous structure?

Clearly not in columns 2 and 5 as identified by the

PATENT
Docket NCR-11453

examiner. The former is a mere summary describing a "pattern," without any disclosure thereof. And, the latter expressly describes the "narrow band," which according to figures 5 & 10 is clearly longitudinally continuous.

The latter reference also describes, but does not illustrate, "only corners," yet such corners have no disclosed relevance to the recited adhesive column, and the examiner has not shown otherwise.

Miles clearly discloses at col. 4, ll. 56+; col. 12, ll. 6+; and col. 13, ll. 46+ the continuous band or stripe configurations of the adhesive 26,226, which clearly lack any similarity to the columnar patches recited in all the claims.

The continuous stripe configuration disclosed and illustrated in figures 5 & 10 of Miles may also be formed in lines of dots, which is not illustrated, but would nevertheless appear to match the continuous longitudinal pattern of adhesive repeatedly described by Miles for its specific purpose.

Accordingly, the examiner has failed to identify in Miles any analogous plurality of adhesive patches aligned in a column as recited in all claims since the bands, stripes, corners, and dot lines clearly do not meet this combination of features.

And, in claim 1 the remaining major area of the back surface is devoid of adhesive unlike figures 9 & 10 of Miles as used by the examiner which illustrate the adhesive 226 over 50% area, although figure 5 is different; but figure 5 illustrates a continuous adhesive band.

As for corner adhesive, such species has no bearing on the claims. And, as for the lines of dots, those lines and dots are not illustrated and are subject to mere examiner speculation, and cannot support a Section 102 rejection. Those multiple lines of dots by express disclosure are multiple lines, and would not meet the recitation in claim 1 of devoid of adhesive away from the recited column of patches.

The examiner's reference to col. 6 for claims 1, 3, & 19 fails to support the recited combinations of columnar patches

PATENT
Docket NCR-11453

and cooperating release strip in view of the continuous form of the adhesive band or stripes disclosed in Miles.

As for claims 2, 4-7, 23 & 24, the examiner's reference to col. 12, ll. 13-24 does not support the specific features and specific combinations recited in these claims.

That reference, as indicated above, merely confirms the continuous stripe or band of adhesive 26,226 shown in figures 5 & 10 of Miles, which cannot match the columnar patches of adhesive recited in these claims.

The non-illustrated corner species of Miles is clearly inapposite.

And, the non-illustrated lines of dots species is also clearly inapposite as indicated above.

The examiner's attempt to select features from different species in Miles, both illustrated and non-illustrated cannot be used to support a rejection under Section 102 which requires identity of elements in the same combination and same cooperation in a single species in a reference, such as Miles, or Mertens as distinguished above.

Does a "dot" have a straight edge as recited in claims 4-7, for example?

Does a "dot" have a rectangular configuration, either parallel or transverse?

The examiner is not permitted to speculate from a reference; the requirement under Section 102 is quite clear. The reference must clearly disclose each and every feature in the same combination, and Miles clearly does not.

The examiner's reference to col. 12, ll. 40-45 is yet again no basis to reject claims 8, 15, & 25 since that reference merely identifies eyemarks without regard to the figures, or the features of these claims.

The eyemarks 85 are illustrated in figure 5 remote from the adhesive 26; and the eyemarks 285 are embedded in the web shown in figure 11, apparently within the adhesive 226.

In claim 8, the marks 42 are disposed between the adjacent

PATENT
Docket NCR-11453

patches, which is clearly distinguishable over the eyemarks 85,285 which are not disposed between adhesive patches.

In claim 8, the marks also define the labels therebetween, but in figure 10 the eyemarks 285 are contained inside each label, and define only the cut edge between adjacent labels.

Claim 8 also recites a single adhesive patch in the label in a combination neither disclosed nor shown in Miles in either the striped adhesive species or the non-illustrated plurality of dots.

Claims 15 and 25 are similarly distinguishable over Miles.

The examiner's reference to col. 6, ll. 41-47 fails to meet the examiner's mere recapitulation of claims 17, 18, 22, and 29, and has now changed from the figure 10 species previously used to the figure 5 species, without regard to the differences therebetween, and without regard to the claims from which these claims depend.

Col. 6 clearly discloses the silicone coating on the top side 55b of the web, which is not qualified by anything narrower than the full width of that top side 55b. The corresponding top side 255b in figure 10 would appear to be the same.

Claims 17, 22, & 29 recite a narrow release strip 40B conforming in width with the column of patches, yet the examiner has provided no evidence in Miles that the top sides 55b, 255b coatings are narrower than the full width thereof, or conform to the different species of continuous adhesive bands 26,226.

As for claim 18, the examiner has failed to show the combination recited in this claim, and has taken the silicone coating recited therein out of context. The silicone disclosed in Miles clearly does not cooperate with any analogous column of adhesive patches.

The examiner may be entitled to broadly construe claim elements, but that interpretation must be consistent with the ordinary definition of elements, and must conform with the

PATENT
Docket NCR-11453

description thereof in Applicants' specification.

That specification is quite clear on the meaning of the various species of adhesive patches.

The specification is also clear on the configuration thereof and the recited alignment in columns.

And, equally clear is the teaching in Miles of continuous stripes or bands or lines of dots or corners of adhesive having no counterpart in these claims, and Miles clearly does not anticipate the various combinations recited.

The examiner's remarkably broad interpretation of the claims similarly broadens the scope thereof for later infringement analysis; yet the examiner is duty bound to provide evidence and identify corresponding elements thereof in the same combinations recited in the claims. And, this the examiner has not done in the general recapitulation of Applicants' own claim language, and the general reference to features in Miles without regard to context, and without regard to the different species, both illustrated and not illustrated.

A Section 102 rejection requires more than the simple contentions made by the examiner, and therefore the rejection of the claims under Miles lacks merit.

Accordingly, withdrawal of the rejection of claims 1-8, 15, 17-19, 22-25, 28, and 29 under Section 102(b) over Miles et al is warranted and is requested.

However, as an accommodation to the examiner's remarkably broad interpretation of the various claims and the applied references, independent claims 1 & 19 are being similarly amended to emphasize the columnar configuration of the plural adhesive patches.

Applicants' specification presents many problems with typical labels which are not solved by the different configurations disclosed in Mertens and Miles.

In particular, adhesive gumming is a problem when processing linerless roll labels through printers, and the specific introduction of adhesive-free spaces in the label roll

PATENT
Docket NCR-11453

reduces or eliminates this problem as explained in the specification.

Accordingly, claims 1 & 19 have been similarly amended to specifically recite the adhesive-free spaces between the longitudinally spaced apart adhesive patches aligned in the column, with the spaces transversely bridging the web. This combination is illustrated in the several figures and disclosed at paras. 29, 40, 43, 48, & 50, for example.

Claim 19 emphasizes the single column of noncontiguous adhesive patches.

The so-separated patches of adhesive provide the many advantages disclosed in the specification, including reducing or eliminating adhesive gumming when the individual labels are cut at the adhesive-free spaces, and the various species of patches provide corresponding advantages as disclosed in the specification.

As indicated above, both Mertens and Miles illustrate continuous bands of adhesive, and disclose corresponding species having corners or lines of dots.

None of such species corresponds to the various embodiments recited in claims 1-30 either under the stringent requirements under Section 102, or under the equally stringent requirements under Section 103.

And, those species of Mertens and Miles would not enjoy the various advantages disclosed in Applicants' specification which are quite relevant to the whole analysis of these claims.

For example, it is quite apparent that cutting of the webs in Mertens and Miles would require cutting through the continuous bands of adhesive leading to the undesirable gumming problem in the cutting machine.

Should the examiner persist in the remarkably broad interpretation of the claims, as now amended, and the references of record, then such interpretation should be clearly entered by the examiner into the file wrapper to maintain the integrity thereof.

PATENT
Docket NCR-11453

Any further examination of this application should remove the uncertainty in claim interpretation found in the examiner's brief remarks. If the examiner intends to find that the longitudinally continuous adhesive bands illustrated in Mertens and Miles are somehow being interpreted for the plurality of adhesive patches aligned in a column along the running axis as recited in Applicants' claims, then this apparent impossibility should be well explained for further evaluation.

The differences between Applicants' invention and the disparate teachings of Mertens and Miles are quite significant and profound; and this attorney welcomes any constructive suggestions from the examiner to address differences in apparent meaning and interpretation of the various claim features.

It is not feasible to speculate as to the examiner's intention and basis for rejection, and, perhaps, the examiner can now recognize Applicants' dilemma in attempting to appreciate the examiner's position. The claims have been amended in a showing of good faith in one attempt to emphasize the significant differences of the recited rolls over the applied references.

And, should the examiner require further amendment conforming therewith to resolve any further differences of interpretation, Applicants would welcome suggestions therefor.

The additional reference cited, but not applied, has been noted.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider all the art of record, including the additional references not applied, to ensure full compliance with the required thoroughness of examination.

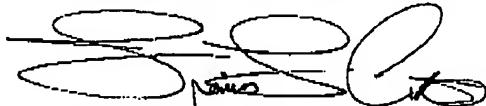
In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the

PATENT
Docket NCR-11453

Board of Appeals has further elaborated on the importance of this examiner duty in *Ex parte Schricker*, 56 USPQ2d 1723 (B.P.A.I. 2000).

In view of the above remarks, allowance of all claims 1-30 over the art of record is warranted and is requested.

Respectfully submitted,



Francis L. Conte
Registration No. 29,630
Attorney for Applicant

Date: 13 January 2006

6 Puritan Avenue
Swampscott, MA 01907
Tel: 781-592-9077
Fax: 781-592-4618